

### **REMARKS**

The Office Action mailed May 18, 2004 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

#### **I. Summary of Claims**

Claims 81-127 are currently pending in the application, with claims 58-80 being cancelled. In the Office Action, the Examiner rejected claims 58-80 as follows:

- Claims 58-59, 61-65, 71-73, 76-77, and 80 were rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of International Publication Number WO 91/10376 (hereafter referred to as the PCT Application) and either U.S. Patent Number 2,080,469 to Gilbert or European Patent Application Number 215,974 (hereafter referred to as the European Application);
- Claims 66-67 and 69-70 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the PCT Application and either Gilbert or the European Application, and further in view of Official Notice; and
- Claims 60, 68, 74-75, and 78-79 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the PCT Application and either Gilbert or the European Application, and further in view of U.S. Patent Number 5,313,717 to Allen, et al.

#### **II. The New Claims Patentably Distinguish Over The Applied Prior Art**

The PCT Application is the primary reference utilized for rejecting each of the claims and discloses an article of footwear having an upper and a sole. One or more sacs are located within the sole, and one or more tubular ducts extend from each sac. The tubular ducts are positioned on an exterior of the upper, and the tubular ducts are in fluid communication with the sacs. One-way valves may be positioned within the tubular ducts to direct fluid flow.

Independent claim 81 recites, in part, that at least one elongate indentation extends through at least a portion of each of the first surface of the sole portion and the first surface of the foot portion, at least a portion of the indentation being unconnected to the second surface of the sole portion and the second surface of the foot portion. Similarly, independent claim 122 recites that an elongate indentation is formed in each of the sole portion and the foot portion, at least a

portion of the indentation being unconnected to an opposite side of the bladder. The PCT Application does not teach or suggest the presence of an indentation having this configuration (i.e., extending from the sole portion to the foot portion). Furthermore, this configuration is not taught or suggested by Gilbert, the European Application, or Allen, either along or in combination with the PCT Application.

Independent claim 94 recites, in part, that a thickness of the sole portion is greater than a thickness of the foot portion. Referring to Figure 2 of the PCT Application, the relative thickness between portion of the component are substantially similar and the description of the component does not incorporate a teaching of the relative thicknesses. Furthermore, this configuration is not taught or suggested by Gilbert, the European Application, or Allen, either along or in combination with the PCT Application.

Independent claim 107 recites, in part, that a surface of the foot portion is substantially flush with a sidewall of the sole assembly. This configuration is not taught or suggested by any of the prior art references applied to the prior claims.

### III. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission with a one-month Petition for Extension of Time and a Request For Continued Examination on September 17, 2004. Should additional fees or be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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